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09/922,076	08/02/2001	Takahisa Kageyama	393032027500	8741

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
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2137

MAIL DATE	DELIVERY MODE
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08/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/922,076

Applicant(s)

KAGEYAMA ET AL.

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7 and 9-12 is/are pending in the application.
4a) Of the above claim(s) 2-4, 6, 8 and 13-15 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 5, 7 and 9-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/7/07 has been entered.
2. This office action is in response to the communication dated 6/7/07 with the amendments to claims 1 and 9-12 and the cancellation of claims 2-4, 6, 8 and 13-15.
3. Claims 1, 5, 7 and 9-12 are pending.

Response to Arguments

4. Applicant's arguments filed 6/7/07 have been fully considered but they are not persuasive. The applicant argues that Sugiyama does not disclose recording information indicative of the setting of the set specific function to a removable recording medium. The examiner respectfully disagrees, Sugiyama discloses a blank tape containing previously recorded copy permission information, which is indicative of permission to copy or not, copyrighted data can be properly protected (see Sugiyama: col. 4, lines 1-7) and further even when the protective information indicative of the copy inhibition is transmitted from the reproducing medium, where the copy permission information (pre-recorded in the blank tape) indicates that copying is permitted onto the

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recording medium, the AV or DTV data can be copied (see Sugiyama: col. 4, lines 31-36). Therefore setting a specific function is recorded to a recording medium.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recording setting information indicating of the removal of copyright restrictions (stated in the remark, page 9, lines 2-3) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues the combination of the three references. The examiner submits that Ogino is directed to a method, device and recording medium for output control and duplication prevention control using an anti-duplication control signal recorded in a recording medium together with an information signal (see Ogino: col. 1, lines 14-18), Kato is directed to a data processor and data processing method (see Kato: col. 1, lines 9-10) and Sugiyama is directed to a recording medium and a recording and reproducing apparatus which inhibits or restricts the recording (dubbing) and reproduction of a digital signal in order to protect its copyright (see Sugiyama: col. 1, lines 20-23). Therefore it is proper to combine their teachings to address the claimed invention.

Claim Objections

5. Claim 11 is objected to because of the following informalities: "comprising the steps of" should be "comprising steps of".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5, 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino (6,433,946) in view of Kato (5,953,529) in view of Sugiyama et al. (6,744,588) and further in view of Kori et al. (6,687,802).

a) As to claims 1, 9 and 11-12, Ogino discloses a method, device and recording medium for output control and copying prevention control comprising a data storage device that stores digital data, said data storage device capable of storing digital audio data or image data taken in from an outside of the electronic apparatus in accordance with the specific process (Ogino: Fig. 1); a notification section (Ogino: Fig. 8, element 18; col. 13, lines 49-56) that notifies a user of a message calling the user's attention to the presence of copyright protection for digital data subject to the specific process in response to an instruction issued on the specific process; a function-setting section that sets a specific function (i.e. anti-duplication control information indicating copying inhibition, copying permission or generation restriction, Ogino: col. 2, lines 31-33, the anti-duplication control information is added to the video signal and recorded on the recording medium to prevent illegal copying) for removing restriction on the

execution of the specific process when the user indicates an acceptance to the contents of the message.

Ogino discloses the write control signal permits writing the video signal on the recording medium (Ogino: col. 17, lines 5-12; col. 20, lines 43-47) when determination is made by duplication controller whether duplication is to be inhibited or permitted, i.e. Ogino implicitly discloses an execution restriction-removal section that removes restriction on the execution of the specific process based on the set specific function.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of removing the restriction on the execution of the specific process in the system of Ogino so as to make the user interactions with the system more friendly.

Ogino is silent on the capability of having an inhibiting section that inhibits the notification section from notifying the user of the message once upon the user's acceptance to the contents of the message.

Kato is relied on for the teaching of stopping the issue of the warning message once upon the user confirms the execution of the forced writing (Kato: col. 18, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of stopping the issue of the warning message once upon the user confirms the execution of the forced writing in the system of Ogino, as Kato discloses, so as to prevent redundant message and make the system more user friendly.

The combination of Ogino and Kato is silent on the capability of having a setting information storage device that can be mounted with a removable recording medium and stores information indicative of a setting of a set specific function in the removable recording medium; a recording section for storing the information in the mounted removable recording medium; and records information indicative of the setting of the set specific function to the received removable recording medium.

Sugiyama is relied upon for the teaching of having a setting information storage device that can be mounted with a removable recording medium and stores information indicative of a setting of a set specific function in the removable recording medium; a recording section for storing the information in the mounted removable recording medium (Sugiyama: Fig. 3B); recording information indicative of the setting of the set specific function to a removable mounted recording medium (Sugiyama: col. 5, lines 5-18) and removing the restriction on the execution of the specific process based on the information indicative of the setting of the set specific functions (Sugiyama: Figs. 3A-3B; col. 4, lines 54-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having a setting information storage device that can be mounted with a removable recording medium and stores information indicative of a setting of a set specific function in the removable recording medium; a recording section for storing the information in the mounted removable recording medium; recording information indicative of the setting of the set specific function to a removable mounted recording medium and removing the restriction on the execution of the specific process

based on the information indicative of the setting of the set specific functions in the system of Ogino and Kato as Sugiyama discloses so as to better protect its copyright (Sugiyama: col. 1, lines 20-23).

The combination of Ogino, Kato and Sugiyama is silent on the capability of having the function-setting section sets the specific function when the user inputs an instruction for setting the specific function. Kori is relied on for the teaching of having the function-setting section sets the specific function when the user inputs an instruction for setting the specific function (Kori: col. 6, lines 58-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the function-setting section sets the specific function when the user inputs an instruction for setting the specific function in the system of Ogino, Kato and Sugiyama, as Kori teaches, so as to prevent illegal copying based on specific function set by the user (Kori: col. 1, lines 19-22).

b) As to claim 5, the combination of Ogino, Kato, Sugiyama and Kori discloses the notification section notifies the user of the message in dependence on whether unauthorized duplication of digital data on which the specific process is to be carried out is inhibited (Ogino: col. 14, lines 43-47; col. 20, lines 16-23).

c) As to claim 7, the combination of Ogino, Kato, Sugiyama and Kori discloses the notification section displays a message concerning a copyright on a screen or notifies the message by voice in response to an instruction for executing the specific process or an instruction for setting the specific function (Ogino: col. 15, lines 6-10).

d) As to claim 10, the combination of Ogino, Kato, Sugiyama and Kori discloses the setting information storage device and the data storage device are an identical storage device that can be replaced (Sugiyama: Fig. 3B).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


mdn
7/31/07